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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,673	12/31/2003	David R. Hall	66.0043	1672

38046 7590 02/15/2006

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EXAMINER

GAY, JENNIFER HAWKINS

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/707,673

Applicant(s)

HALL ET AL.

Examiner

Jennifer H. Gay

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/5/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 2,5,6,11,14 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7-10,12,13,16-20 and 22 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/13/04, 5/6/04</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Election/Restrictions***

1. Claims 2, 5, 6, 11, 14, and 15 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 5<sup>th</sup>, 2006.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “36” has been used to designate a wall thickness, a wall, and an inner wall. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 12b. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

4. Claims 1, 10, and 19 are objected to because of the following informalities:
- The second occurrence of “a transmission line” and “a downhole tool” in claims 1 and 10 should be changed to the transmission line and the downhole tool as these features were positively recited in the preamble of the claims. Appropriate correction is required.
  - In line 2 of claim 19, “the apparatus” should be changed to --the method--.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3, 4, 7, 8, 10, 12, 13, 16, 17, 19, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Hawthorn (US 2,197,392).

*Regarding claim 1:* Hawthorn discloses an apparatus for bonding a transmission line **15** to the inside diameter of a downhole tool **10**. The apparatus includes a pre-formed interface **14** for bonding the line to the inside diameter of the tool. The interface includes a first surface that conforms to the inside contour of the transmission line and a second surface that conforms to the inside diameter of the tool (Figure 3).

*Regarding claims 3, 4, 12, 13:* The first surface is bonded to the transmission line via an adhesive material **18**.

*Regarding claims 7, 16:* The second surface is bonded to the inside diameter of the tool via welding (2:32-37).

*Regarding claims 8, 17:* Hawthorn does not disclose how the pre-form is specifically formed, however, the method of forming the device is not germane to the issue of patentability of the device itself as the device disclosed in the applied reference is

capable of being formed in the manner(s) listed. Therefore, this limitation has been given little patentable weight.

*Regarding claim 10:* Hawthorn discloses the method for bonding the transmission line to the tool using the above apparatus.

*Regarding claim 19:* Hawthorn discloses a method for bonding a transmission line **15** to the inside diameter of a downhole tool **10**. The method involves the following steps:

- Positioning the line near the inside wall of the tool.
- Positioning a mold **14** near the line and the inside wall.
- Injecting a bonding material **18** into the mold such that the material bonds the line to the wall.
- Curing the bonding material.

*Regarding claim 21:* Though not specifically disclosed, the wall and the line would inherently be prepped prior to the injection of the material.

*Regarding claim 22:* The method further involves forming gaps **27** in the material at desired intervals along the material.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being obvious over Hawthorn in view of Thomeer (US 4,971,147).

Hawthorn discloses all of the limitations of the above claim(s) except for the pre-formed interface engaging at least one recess milled in the surface of the inside diameter of the tool.

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Thomeer discloses an apparatus similar to that of Hawthorn. Thomeer further teaches connecting the pre-formed interface **20** to the tool **30** via a recess **28** in the tool.

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the apparatus of Hawthorn to include a recess into which the pre-formed interface was inserted as taught by Thomeer in order to have provided an additional means for securing the interface and thus the line to the tool.

### ***Allowable Subject Matter***

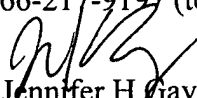
9. Claim 20 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H. Gay whose telephone number is (571) 272-7029. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jennifer H. Gay  
Primary Examiner  
Art Unit 3672

JHG   
February 10, 2006